

Remarks

The Examiner has objected to independent claim 8 because it recites "a three-position vacuum switching chamber which the Examiner says should be changed to "a vacuum switching chamber". Applicant has made that amendment to claim 8.

In the Office action, the Examiner has rejected claims 8-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,812,314 to Nonken (the "Nonken Patent") in view of U.S. Patent No. 6,720,515 to Renz et al (the "Renz Patent").

The Nonken and Renz patents are discussed in Amendment D filed in this application on August 22, 2010 and that discussion is incorporated herein by reference. Applicant's further comments about these two patents and the manner in which they been combined by the Examiner in the present Office Action are given below.

In the present Office Action, the Examiner says that the Nonken Patent discloses everything called for in claim 8, the only independent claim pending in this application, except for the conductive edge board and its connection to the wall of the enclosure called for in that claim. The Examiner then says that the Renz Patent discloses a switchgear with a three position switch and having a conductive edge board connected as called for in claim 8 and concludes that it would have been obvious to provide the conductive edge board as suggested by the Renz Patent in the bushing described in the Nonken Patent.

As is discussed in Amendment D, "[T]he Nonken Patent discloses a multi-terminal bushing 1' having a molded epoxy resin housing 1 a' that encapsulates a pair of vacuum switches 4', 4". Way below the vacuum switches 4', 4",

toward the bottom of the housing 1 a', a steel flange 2' is partially molded into the housing 1 a'. The steel flange 2' is welded to a steel tank 16 filled with an insulating gas, such as Freon. The vacuum switches 4', 4" are not three-position switches and do not have a grounding contact." The steel flange 2' of Fig. 3 and also steel flange 2 of Fig. 1 are, as is described in the Nonken Patent at lines 16 to 21 of column 3, used as part of a sturdy mounting means to "rigidly mount the bushing 1 in a desired operating position relative to a transformer tank or other structure".

The bushing 1 of Fig. 1 or 3 of the Nonken Patent comprises a housing 1a of Fig. 1 and 1a' of Fig. 3. The housings 1a and 1a' are made from electrically insulated epoxy resin (see column 2, lines 66 to 67 and column 7, lines 34-35). The annular steel flanges 2 of Fig. 1 and 2' of Fig. 3 are molded in a watertight relationship within the epoxy housing and the outer peripheral edge of the flange is adapted to be welded to a steel supporting flange (Fig. 1) or is welded to a steel tank (Fig. 3).

As is called for in independent claims 1 and 8 of the Nonken Patent, the annular steel flange, its molding within the epoxy housing and its either being adapted to be welded to a steel supporting flange (claim 1) or its welding to a tank (claim 8) are part of the mounting means called for in those claims. Thus the combination of the Nonken Patent and the Renz Patent used by the Examiner to reject claims 8-11 would require the invention of the Nonken Patent to be discarded.

As applicant stated in Amendment D, the CCPA held "in *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), if a proposed modification or combination of the prior art would

change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In making its holding, the CPPA stated that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.)."

Based on the foregoing, Applicant submits that the Nonken and Renz Patents cannot be combined as the Examiner has done, and that amended independent claim 8 and the claims 9-11 depending therefrom are patentable over those patents. Accordingly, Applicant submits that the present application is in a condition for allowance and notice to that effect is hereby requested.

Respectfully submitted,

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